

Saito et al, or as unpatentable under 35 USC 103(a) over Saito et al. In addition, claims 1, 2 and 5 are rejected as anticipated under 102(e) over Braun et al, or as unpatentable under 35 USC 103(a) over Braun et al, and claims 3, 4 and 10 are rejected as unpatentable under 35 USC 103(a) over Braun et al in view of Uemura et al. Finally, claims 8, 10 and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 7 and 8 of copending application No. 09/660,291.

Regarding the rejections under 35 USC 102, it is noted that every positively recited limitation must be included in a single reference. See, *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). With respect to Braun et al the examiner has apparently equated the formation of the preform with the formation of the preliminary molded member. There is no equality. The preform does not have "a shape similar to the final molded shape," which the preliminary molded member according to the invention must have. Also, the average particle size claimed and that disclosed by Braun et al are different. With respect to Saito et al, a preform is not even made. The "mixture is pressurized" (column 5, line 17). This does not amount to the formation of a preliminary molded member. Also, the average particle size claimed and that disclosed by Saito et al are different.

It is not enough that the invention claimed and the references have some form of subject matter relationship, it is rather important that the positively recited elements or steps are disclosed exactly. This is not the case here.

Regarding the rejections under 35 USC 103, it is noted that the reference or references relied upon must at least suggest the claimed invention. See, *In re Gordon*, 221

USPQ 1125 (Fed. Cir. 1984). The limitations noted above are not, it is respectfully submitted, taught or suggested by Braun et al or Saito et al or Uemura et al. There are points of coincidence with the present invention but not a teaching or a suggestion.

Regarding the rejection for double patenting, this issue can be resolved by the filing of a terminal disclaimer, if necessary.

The examiner is urged to take the above into consideration when conducting the examination of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Felix J. D'Ambrosio', is written over the typed name.

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OF AMENDED CLAIMS 1 AND 8

1. (Twice Amended) A separator for a fuel cell consisting of a complex which is configured by bonding graphite powder [by means of] and a thermosetting resin to form the separator, wherein

[in said complex] the composition ratio of said graphite powder is set to 85 to 97 wt. %, and a composition ratio of said thermosetting resin is set to 3 to 15 wt. % of said complex,

an average particle diameter of said graphite powder is set to a range of 15 to 125 μm ,

said complex is [previously] first cold-molded at a pressure of 2 to 10 Mpa to form a preliminary molded member, and

[a] said preliminary molded member resultantly obtained is molded at a pressure of 10 to 100 Mpa.

8. (Twice Amended) A method of producing a separator for a fuel cell configured by molding a complex of graphite powder and thermosetting resin, in which composition the ratios are set to 85 to 97 wt.% of graphite powder, and 3 to 15 wt. % of a thermosetting resin, and an average particle diameter of said graphite powder is set to a range of 15 to 125 μm , [wherein] comprising the steps of:

[said complex is previously] cold-[molded] molding said complex into a shape similar to a final molded shape at a pressure of 2 to 10 Mpa forming thereby a preliminary molded member, and

placing said preliminary molded member [is then placed] in a mold [and molded] to mold it into [the] a final shape by applying a pressure of 10 to 100 MPa.

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